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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/502,627 | 02/11/2000 | Martin Tobias | 53326-018 | 5454 |

7590

08/26/2004

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EXAMINER

KE, PENG

ART UNIT

PAPER NUMBER

2174

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/502,627

Applicant(s)

TOBIAS ET AL.

Examiner

Peng Ke

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed on 5/04/2004.

This action is final.

2. Claims 1-20 are pending in this application. Claims 1, 10, and 19 are independent claims. In the Amendment, filed on 5/04/2004, claim 2 and 11 are cancelled, and claims 1, 3-6, 10, 12-15, 18 and 19 are amended.
3. Since applicant fails to traverse the examiner's assertion of official notice, the examiner is taking the office notice to be admitted prior art.

Claim Objections

4. Claim 4 is objected to because of the following informalities: "... the client through entering commands at the to dynamically determine..." Appropriate correction is required.

Examiner interprets claim 4 to be "...the client to entering commands dynamically to determine..."

Claim Rejections - 35 USC § 112

5. Claims 3 and 4 recites the limitation "claim 2". There is insufficient antecedent basis for this limitation in the claim.

Examiner interprets claim 2 to be claim 1.

6. Claims 12 and 13 recites the limitation "claim 11". There is insufficient antecedent basis for this limitation in the claim.

Examiner interprets claim 2 to be claim 10.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by Sparks et al. ("Sparks", US 6,298,385).

As per claim 19, Sparks teaches a method for hosting media content over a network, comprising:

receiving a request to host a media program file in a selected encoding format (col.5, lines 1-6);

encoding the media program in the selected encoding format (col.5, lines 1-6), and

hosting the encoded media file on a hosting server, wherein the hosting server is configured to allow selective access to the encoded media file over a network (col.5, lines 6067).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 5, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al. (US 6,385,596) in view of Gongwer et al. (US 6,138,120).

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As per claim 1, Wiser teaches a method for providing encoded media content over a network, the method comprising the computer-implemented steps of:

receiving over the network a first request to encode one or more media program files;

For each media program file to be encoded, receiving a selection of one or more encoding formats for encoding the media program file, wherein the first request and the selection are received from a client that is connected to the network (col. 10, lines 51-55);

in response to receiving the first request, servicing the first request by automatically generating one or more encoded media files by encoding the media program in the one or more selected encoding formats (col.7, lines 4-14), and

after encoding the media program in the one or more encoding formats,

And if the client does not request hosting of the one or more encoded media files, enabling the client to access the one or more encoded media files without hosting the files for access on a hosting server (col. 9, lines 46-68).

However, Wiser fails to teach if the client, in a second request, request hosting of the one or more encoded media files, automatically hosting the one or more encoded media files on a hosting server (col.9, lines 39-45) wherein the hosting server is configured to allow selective access by visitors to the one or more encoded media files over the network, as determined by the client (col.9, lines 46-68).

Gongwer teaches a method that allows original client of the client-server session to permit another independent client to share the data of the session (col. 1 ,lines 45-56)

It would have been obvious to an artisan at the time of the invention to include Gongwer's teaching with method of Wiser in order to permit the client to share data with a third party.

As per claim 5, Wiser and Gongwer teach the method of claim 1. Wiser further teaches the method wherein the selective access includes access given to a visitor of the network and which allows the visitor to receive a publication of at least one of the one or more encoded media files in response to a request by the visitor to receive the publication (col. 11, lines 51-56).

Claims 10 and 14 are similar in scope to claims 1 and 5 respectively, and are therefore rejected under similar rationale.

Claims 3-4 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al. ("Wiser", US 6,385,596) in view of Gongwer et al. (US 6,138,120).

As per claim 3, Wiser and Gongwer teach the organization of encoded media files into lists. However, they fail to specifically disclose the method allowing the client to create a tree structure directory for organizing the encoded media files. Official Notice is given that using a tree structure directory to organize files is well known in the art. It would have been obvious to an artisan at the time of the invention to include the method of organizing the files into a tree structure directory with Wiser's method as a matter of organization preference and an improved method of locating files efficiently.

As per claim 4, Wiser and Gongwer teach the method claim 1. Wiser teaches the step of providing real-time reporting of statistics on the one or more encoded media files that are hosted at the hosting server (col. 11, lines 51-56). Furthermore, Wiser suggests the client to be able to manage the media files (col. 27, lines 3-4). However, Wiser fails to teach the step of allowing the

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client to entering commands dynamically to determine whether to remove the one or more encoded media files from publication. Official Notice is given that file management to include operations to add/remove is well known in the art. It would have been obvious to an artisan at the time of the invention to include the removal operation with Wiser's method so that the end-user is able to remove files that are no longer of interest thereby being cost effective.

Claims 12-13 are similar in scope to claims 3-4 respectively, and are therefore rejected under similar rationale.

Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al. ("Wiser", US 6,385,596) in view of Gongwer et al. (US 6,138,120) further in view of Sauerwine (US 5,421,620).

As per claim 6, Wiser and Gongwer teach the step of causing a user interface to be displayed at the client, wherein the user interface allows entry of encoding requests and allows uploading of the media program from the client to a server over the network (col.20, lines 65-67; col.21, lines 1-2). However, they fails to teach the step of providing to the client an encoding request form through the user interface, wherein the encoding request form includes a mailing bar code. Sauerwine teaches a method of creating a mailer business form having a mailing bar code (fig. 1, mailing bar code 136). It would have been obvious to an artisan at the time of the invention to include Sauerwine's teaching with method of Wiser and Gongwer in order to provide the option of mailing the media file associated with a bar code for tracking the file.

Claim 15 is similar in scope to claim 6, and is therefore rejected under similar rationale.

Claims 7-8 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al. ("Wiser", US 6,385,596) in view of Gongwer et al. (US 6,138,120) further in view of Vigneaux et al. ("Vigneaux", US 5,852,435).

As per claims 7-8, although Wiser and Gongwer teach the control of managing files, they fail to teach the control of the design of the files. Vigneaux teaches a multimedia editing system providing automated online design control, wherein the design control comprises the control of one or more of sequencing of segments of the one or more encoded media files; selection of music for each segment of the one or more encoded media files; and alteration of the segments of the one or more encoded media files, wherein the segments of the one or more encoded media files comprise two or more slides, frames, or video clips (col.9, lines 1-6). It would have been obvious to an artisan at the time of the invention to include Vigneaux's teaching with method of Wiser and Gongwer in order to allow the user to arrange the media file to the user's viewing preference.

Claims 16-17 are similar in scope to claims 7-8 respectively, and are therefore rejected under similar rationale.

Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al. ("Wiser", US 6,385,596) in view of Gongwer et al. (US 6,138,120) further in view of Candelore (US 6,057,872).

As per claim 9, Wiser teaches the purchasing of media files. However, Wiser and Gongwer fail to teach the purchasing of credits for each transaction. Candelore teaches a credit purchasing system, wherein credits are purchased by an end-user; a predetermined number of credits are associated with each e-commerce transaction associated with the comprehensive

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remote servicing of the media program; and pricing of credits are inversely proportionate to a number of credits purchased (col. 1, lines 65-67; col. 9, lines 10-15). It would have been obvious to an artisan at the time of the invention to include Candelore's teaching with method of Wiser and Gongwer in order to provide a method of purchasing media files whereby continuous users are provided a discount for their loyalty to the service thereby providing incentive for users to purchase many credits.

Claim 18 is similar in scope to claim 9, and is therefore rejected under similar rationale.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sparks et al. ("Sparks", US 6,298,385).

As per claim 20, Sparks teaches the hosting of the media file in different encoding formats (see claim 19 above). However, Sparks does not disclose selecting one of a plurality of servers wherein different servers host different formats for the media file. Official Notice is given that the use of multiple servers to handle a specific type of processing was well known in the art at the time of the invention. It would have been obvious to an artisan at the time of the invention to host the various formatted files on different servers in order to effectively view the files in a timely and efficient manner.

Response to Argument

Applicant's arguments with respect to claims 1-20 have been considered but are deemed to be moot in view of the new grounds of rejection except for the following:

Applicant's arguments include the following:

- A) Wiser doesn't not teach a selection of encoding formats.
- A) Wiser allows user to select music of different quality. The music of lower quality are un-encrypted, and the music of higher are encrypted, so the user is given an selection of encoding formats.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peng Ke whose telephone number is (703) 305-7615. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on (703) 308-0640. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Peng Ke

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